

REMARKS

The present response is submitted in reply to the Office Action issued on September 7, 2007. Claims 1-8, 10 and 11 are pending in this application, all of which have been rejected. By the present response, claims 6, 10 and 11 have been amended. The amendments to claims 10 and 11 are discussed below. Claim 6 is amended solely for placement of a period at the end of the claim. No new matter has been added. Reconsideration is respectfully requested in light of the following remarks.

Rejection of claims 10 and 11 under 35 U.S.C. 112, first and second paragraphs

Claim 10 has been rejected under 35 U.S.C. 112, first and second paragraphs, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. In particular, the Examiner states that the term “antimicrobial” in claim 10 is incorrect since it covers viruses, fungi, protozoa, etc. and suggests that the term should be amended to “antibacterial.” The Examiner’s suggestion has been adopted, as set forth in amended claim 10 above.

The Examiner also states that Formula IVB in claim 10 is not correct since it depicts a trivalent Y, but the choices for Y are both divalent. It is believed that the Examiner intended this rejection to pertain to claim 11 and so the response is directed to claim 11 accordingly. The Applicants submit that claim 11 has been amended by deleting the R₈ portion of formula IVB in claim 11, as set forth above in amended claim 11.

In view of the aforementioned amendments to claims 10 and 11, withdrawal of this rejection is respectfully requested.

Objection of claim 7

The Examiner has objected to claim 7 as being of improper dependent form

for failing to further limit the subject matter of a previous claim. In particular, the Examiner is asking that claim 7 be deleted, amended to be placed into proper dependent form or amended to be placed into independent form.

The Applicants respectfully submit that claim 7 is a proper independent claim and that reference to claim 1 is proper in this instance. In particular, the Applicants refer to M.P.E.P. 2173.05(f) which provides that [a] claim which makes reference to a preceding claim to define a limitation is an acceptable claim construction which should not necessarily be rejected as improper or confusing under 35 U.S.C. 112, second paragraph. For example, claims which read: "The product produced by the method of claim 1." or "A method of producing ethanol comprising contacting amylose with the culture of claim 1 under the following conditions" are not indefinite under 35 U.S.C. 112, second paragraph, merely because of the reference to another claim. See also *Ex parte Porter*, 25 USPQ2d 1144 (Bd. Pat. App. & Inter. 1992) where reference to "the nozzle of claim 7" in a method claim was held to comply with 35 U.S.C. 112, second paragraph.

Therefore, withdrawal of the present objection is respectfully requested.

Double Patenting

The Examiner has rejected claims 1-8 and 10-11 as being provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 and 14-15 of co-pending Application No. 10/527,882. It is believed that the double-patenting rejection properly pertains to U.S. Patent No. 6,531,465 (Ascher, et al.). The '882 serial number discussed in the double-patenting rejection is that of the present application. More particularly, the Examiner states that although the conflicting claims are

not identical, they are not patentably distinct from each other because of substantial overlap between the claims of the two cases, namely, two esters in the '465 patent (those of Examples 15 and 22) fall within the rejected claims. In addition, the Examiner states that regarding claims 6-7, in the cephalosporin art, the ester would make the parent acid or salt obvious since the esters are normally made from the acid or salt. Lastly, with regard to claim 11, the Examiner states that compounds and their manufacture are not normally patentably distinct.

A terminal disclaimer is submitted herewith for overcoming this nonstatutory obviousness-type double patenting rejection. Withdrawal thereof is respectfully requested.


Conclusion

In light of the foregoing claims and arguments, it is believed that the present application is in condition for allowance, and such action is earnestly solicited. The Examiner is invited to call the undersigned if there are any remaining issues to be discussed which could expedite the prosecution of the present application.

Respectfully submitted,

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